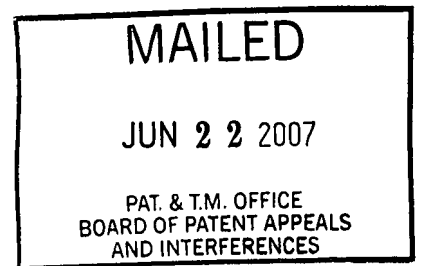1   RECORD OF ORAL HEARING
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3   UNITED STATES PATENT AND TRADEMARK OFFICE
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6   BEFORE THE BOARD OF PATENT APPEALS
7   AND INTERFERENCES
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10   Ex parte JEFFREY P. SZMANDA
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                    _____
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13   Appeal 2007-0220

14   Application 09/982,640

15   Technology Center 2100

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18   Oral Hearing Held: May 23, 2007
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22 Before JAMES D. THOMAS, JOSEPH F. RUGGIERO, and

23 ALLEN R. MACDONALD, Administrative Patent Judges.

24

25 ON BEHALF OF THE APPELLANT:

26

27   CHARLES R. SZMANDA, ESQ

28   4 Crossman Avenue

29   Westborough, MA 01581

30

31   The above-entitled matter came on for hearing on Wednesday, May

32 23, 2007, commencing at 09:30 a.m., at The U.S. Patent and Trademark

33 Office, 600 Dulany Street, Alexandria, Virginia.

1   JUDGE THOMAS: Good morning, sir. How are you?

2   MR. SZMANDA: Good morning.

3   JUDGE THOMAS: Have you been to the Board before?

4   MR. SZMANDA: I have never been to the Board before, sir.

5   JUDGE THOMAS: Okay. We give you 20 minutes, normally, for

6 arguments.

7   MR. SZMANDA: Okay.

8   JUDGE THOMAS: You can use that clock as a guide, if you would

9 like. We are kind of generally familiar with the record and the file and the

10 disclosure, so you can proceed at your prompting.

11   MR. SZMANDA: Okay.

12   JUDGE MacDONALD: Introduce the --

13   JUDGE THOMAS: Yes. Your colleague, who should be

14 introduced.

15   MR. SZMANDA: I will do that, sir.

16   JUDGE MacDONALD: I meant, we also have some other members

17 of the Board and attorneys and interns, who are in the back. That it.

18   MR. SZMANDA: Well, good morning, Your Honors. Thank you

19 very much for hearing me today. My name is Charles Szmanda. I am the

20 agent who is appealing this case for my client, Mr. Jeffrey Szmanda, who is

21 the founder of Madison Avenue Tools of Milwaukee, Wisconsin. He is an

22 entrepreneur and business owner. His first product is a product called

23 Moreaboutthisad.com, which is a product that searches the internet for -- or

24 searches a database for the content of an advertisement.

1   In this appeal, claims 1, 11, 25, 39 and 42 are the independent claims

2   under appeal. And they are rejected in view of Skillen, 6,098,065, and Loeb,

3   6,421,652.

4   We have submitted arguments in our brief regarding the dependent

5   claims -- several dependent claims, as well. These received no response

6   from the Examiner in the Examiner's Answer. And so we ask that the

7   appropriate action be taken under MPEP 1207.02, and also Ex parte M.

8   Let's look at claim 1. Claim 1 is a method of supplying

9   advertisement information to a user searching for said information within a

10   data network comprising the steps of receiving from the user a series of

11   search rules comprising facts about an advertisement, and accessing a

12   database comprising details of a plurality of advertisements, using a search

13   engine to apply said search rules to said database, and reporting to the user

14   the results comprising a subset of the contents of said database.

15   Now, receiving from the user a series of search rules comprising

16   facts about an advertisement was defined for us by the Examiner.

17   However, my client has provided ample definition of the phrase and

18   description of the phrase -- paragraph 35 of his application, the search rules

19   can comprise key words or phrases describing the advertisement in some

20   way. A description of the color schemes used in the advertisement, a

21   description of music heard in the advertisement, visual cues perceived in the

22   advertisement, a description of a plant, animal or human model or models

23   used in the advertisement.

24   JUDGE MacDONALD: Excuse me. All of those are text queries?

25   None of those are based on you selecting a color? They are all text-based?

1   MR. SZMANDA: They could be text-based or they could be entered

2 in -- as a result of a question from, for example, the database itself.

3   JUDGE MacDONALD: Okay.

4   MR. SZMANDA: Or perhaps a description of the social situation

5 depicted in the advertisement. Now, my client has further gone ahead and

6 brought us Figure 7, where he actually shows an example of that. In Figure

7 7, for example, the user is asked to write down what is remembered about

8 the advertisement. And the user writes down a woman was climbing the

9 stairs and walking fast. So, that is kind of an example of that.

10   Now, the Examiner has throughout prosecution -- every time we

11 have answered one -- answered the Examiner's arguments based on a set of

12 quotations from the Skillen or Loeb references, the Examiner simply comes

13 up with some new quotations.

14   Finally, in the Examiner's Answer, three quotations from Skillen

15 were proffered. I will not read them for you, but none of them have

16 anything whatsoever to do with a user in Skillen inputting a series of search

17 rules comprising facts about an advertisement. Those quotations, by the

18 way, are in our brief and very easy to find.

19   Instead, Skillen's user is inputting anything. Nowhere in Skillen does

20 it say anything about what the user inputs, except to say that the user is

21 searching for information, in column 2, line 30 -- or desired information,

22 from the Abstract, or column 1, lines 40, 51 and 59. Or in column 2, line 4,

23 in claim 1.

24   In Loeb, the input that the user provides there is the result of a

25 universal questionnaire. And the universal questionnaire solicits -- and I

26 quote from Loeb -- "certain consumer information." That does not comport

1   with the ordinary meaning of advertisement information, and it certainly

2   doesn't comport with the meaning --

3   JUDGE MacDONALD: Let me stop you there for a second. I am

4   unclear why you are focusing on the information. How does that

5   functionally change the database? I mean, I see in the claim --

6   MR. SZMANDA: The claim is, of course – the claim recites that the

7   user inputs information about an advertisement that the database contains.

8   JUDGE MacDONALD: Again, but the functionality of the database

9   -- I am assuming that this is an off-the-shelf database intended to store all

10   kinds of information, any -- the developer of the database intended that to

11   take any information you could come up with.

12   And the database was not modified in order to put the advertisement

13   information into it, so I am trying to picture how these functions changed

14   beyond it's a new type of information.

15   MR. SZMANDA: Well, the search engine may not change. The

16   search engine may be standard kinds of -- may provide kinds of things. We

17   describe that in the application. However, the database is specialized for this

18   purpose.

19   JUDGE MacDONALD: In what way?

20   MR. SZMANDA: Well, the database, as it says in the claim,

21   comprises details of a plurality of advertisements --

22   JUDGE MacDONALD: Again, it is the particular type of

23   information.

24   MR. SZMANDA: A particular type of information. That is correct,

25   sir.

1   JUDGE MacDONALD: But the software – the database software is

2   -- sounds to be just off-the-shelf database software.

3   MR. SZMANDA: Yes.

4   JUDGE MacDONALD: The same as shown in the references.

5   MR. SZMANDA: It could be. But we are not claiming the software.

6   We are claiming the specific kinds of information, and the --

7   JUDGE MacDONALD: Well, that being the --

8   JUDGE THOMAS: The patentability is predicated on the nature of

9   the information?

10   MR. SZMANDA: Yes, sir.

11   JUDGE MacDONALD: Yes, and my concern there is that the case

12   law is pretty specific, that that's it -- patentability has to be predicated on the

13   structure or function. Not on information.

14   MR. SZMANDA: But in this particular case, the database -- in this

15   particular case, sir, the data supplied to the user is the function. It is the –

16   the result is that the user then obtains data regarding an advertisement.

17   This is not the structure of the information, it is the result of the

18   search and the subset of the contents of the database that comes to it.

19   JUDGE MacDONALD: I am trying to picture how that changes the

20   functions that are taught in the prior art, which are the user receives

21   information of some kind.

22   MR. SZMANDA: Well, that is true. There are many examples --

23   JUDGE MacDONALD: Do you know what I'm saying? The

24   information will be given --

25   MR. SZMANDA: -- examples where the user receives information

26   of some kind.

6

1   JUDGE MacDONALD: Yes.

2   MR. SZMANDA: There are many examples of that. In this

3 particular case, we are claiming a database which has certain information

4 which is useful to the user.

5   JUDGE THOMAS: So what of claim 1 is not in the reference?

6   MR. SZMANDA: Neither reference teaches search rules comprising

7 facts about an advertisement input by the user.

8   JUDGE MacDONALD: Can I stop you there, because I think you

9 said -- you included things that are the reference in that statement.

10   MR. SZMANDA: Uh-huh.

11   JUDGE MacDONALD: The references teach search rules. The

12 references do not teach advertising information.

13   MR. SZMANDA: That is correct.

14   JUDGE MacDONALD: Okay.

15   MR. SZMANDA: And neither -- I mean, neither references teaches

16 details of a plurality of advertisements in the database. So, neither reference

17 does that, either.

18   JUDGE THOMAS: So, let's clarify something from my point of

19 view. Your position is that patentability is predicated on the fact that

20 advertising information is in the database as opposed to generic kind of

21 information.

22   MR. SZMANDA: Correct, sir. The rejection was based on 102, and

23 our position is that the details of the claim are not taught in either of these

24 references.

25   JUDGE THOMAS: What, all the details? Or just the one detail?

1   MR. SZMANDA: Well, the details in particular that we are talking

2   about here today are the user inputs a series of search rules comprising facts

3   about an advertisement, and accessing a database comprising details of a

4   plurality advertisements. Those are the two elements which are not in the

5   prior art, and which are taught and disclosed in my client's application.

6   JUDGE THOMAS: So, does the reference teach anything about

7   searching a database by user inputs, do you?

8   MR. SZMANDA: Sure! Yes, sir.

9   JUDGE THOMAS: But your position is to key in on the fact -- the

10   urging that it is not advertising information of some kind that is either stored

11   or keyed in?

12   MR. SZMANDA: That is correct.

13   JUDGE THOMAS: That is the whole premise of this appeal?

14   MR. SZMANDA: Yes. If I understand your question correctly, the

15   premise of this appeal is that the Examiner's rejections fail under 102,

16   whether 102b or 102e, based on the fact that my client's claims are -- deal

17   with specifically a series of search rules comprising facts about an

18   advertisement, and accessing a database whose details -- comprising details

19   of a plurality of advertisements.

20   JUDGE THOMAS: Okay. That helps the context of our

21   consideration of the arguments in the record. All right?

22   MR. SZMANDA: Yes, sir.

23   JUDGE THOMAS: All right.

24   MR. SZMANDA: Thank you, sir.

1   JUDGE THOMAS: One other question while I have your attention.

2   You asserted that the Examiner did not address any arguments presented as

3   to the dependent claims in the Answer?

4   MR. SZMANDA: Yes. In our Reply Brief, we list all of the

5   arguments that were dealt with in the Appeal Brief, and not addressed by the

6   Examiner.

7   JUDGE THOMAS: Okay. So, you have repeated the arguments in

8   the Reply Brief that were asserted in the Brief as to the dependent claims?

9   MR. SZMANDA: That is correct. Yes, sir.

10   JUDGE THOMAS: Okay. And furthermore, the Examiner did not

11   respond in the responsive arguments portion of the answer to the arguments

12   you made in the principal brief as to those dependent claims?

13   MR. SZMANDA: That is correct, sir.

14   JUDGE THOMAS: Okay.

15   MR. SZMANDA: Thank you. With regard to claim -- we will not

16   spend a lot of time -- any more time on claim 1. I think you got the point on

17   claim 1.

18   With regard to claim 11, the Examiner's rejections fail regarding

19   claim 11, certainly on the basis of 102 -- because of claim 11 and 25,

20   actually -- because claim 11 recites, inter alia, querying the user to obtain

21   one or more search rules comprising facts about an advertisement, and then

22   accessing a database comprising details of a plurality of advertisements, as

23   before.

24   However, in claims 11 and 25, we also assert querying the user.

25   Now, in this case, we do have a user query, in very much the same way, as

26   we show in Figure 7 of my client's application.

1   However, Skillen, neither -- Skillen does not teach any kind of a user

2   query. There is no query at all. In Skillen we see only that the user is

3   inputting something at some time to a database. So, a user query isn't there.

4   Loeb, on the other hand, does have a user query, but in Loeb, the

5   user query involves certain consumer information.

6   JUDGE MacDONALD: Can I ask you for clarification here?

7   MR. SZMANDA: Of course.

8   JUDGE MacDONALD: You are using the term "user query" and I

9   am -- my understanding was in one situation it is a query by the user, and in

10 another situation, it is a query of the user.

11   MR. SZMANDA: This is a query of the user.

12   JUDGE MacDONALD: Okay.

13   MR. SZMANDA: And specifically, sir, what we are talking about is

14 the user sitting down, and, for example, encountering a screen that says,

15 where did you see the ad. Did you see it on television, did you hear it on the

16 radio, was it on a billboard. Tell us what you remember about the ad, and so

17 on and so on.

18   So, the query of the user is what we are talking about here.

19   JUDGE MacDONALD: Of the user by the database?

20   MR. SZMANDA: By the database or by the software. Yes. That is

21 correct. By the website.

22   And that is in claims 11 and 25. That is, of course, a very small

23 distinction.

24   However, very small distinctions do frequently defeat anticipation

25 rejections and I think it would do so here.

1   JUDGE MacDONALD: Is this on anticipation or an obviousness

2   rejection? I thought it was obviousness.

3   MR. SZMANDA: In the case of the Skillen reference, the Examiner

4   has rejected based on 102b. In the case of the Loeb reference, the Examiner

5   has rejected claims 11 and 25 based on obviousness.

6   JUDGE MacDONALD: Okay. That's what I thought.

7   MR. SZMANDA: Okay. In that case, however, all of the claims are

8   not taught or suggested at least, for example, the Loeb reference has a

9   universal questionnaire which requests certain consumer information.

10   JUDGE MacDONALD: In the last five minutes, let me -- sorry to

11   put you on the spot, but I think it is an important claim that you need to

12   address, since this is a 103 rejection.

13   What is the impact, as you see it, of KSR on these claims?

14   MR. SZMANDA: I see no impact, sir. The KSR v. Teleflex case

15   has to do with the question of whether there is a motivation to combine or

16   modify. In this case, what we are claiming is that all of the claim limitations

17   are not taught or suggested by the reference. In fact, that is manifestly true.

18   So, KSR has no bearing on this case.

19   Claims 39 and 42 are the remaining two claims that are independent

20   claims in this case. Claim 39 is a method of facilitating demographic

21   research – a little bit different now -- by supplying advertisement

22   information to a user searching for information on a data network, and so on.

23   And the claim recites receiving a set of search terms comprising

24   words having targeted connotative significance to a particular demographic

25   segment, and then accessing the database comprising details of a plurality of

26   advertisements. Now, that is the rest of the claim.

1   We would like to focus on -- because we have already done this in

2   the past arguments, we would like to focus on a set of search terms

3   comprising – having targeted connotative significance to a particular

4   demographic segment.

5   The concept of connotation has absolutely no appearance in Skillen

6   or Loeb.

7   JUDGE MacDONALD: Could you tell us what you mean by that

8   term?

9   MR. SZMANDA: Yes, sir. We define that on paragraph 18 of the

10   application, but I am more than happy to tell you what I mean by the term.

11   "Connotation" in the context of connotative meaning is that which carries

12   more than the literal meaning of a term.

13   So that, for example, some -- let's use the word "score". We use that

14   in the application. A score is literally the accumulation of points in a game.

15   However, we also say that a person is said to "know the score". We also say

16   that a person is said to have "settled the score", for example, when he

17   extracts revenge for something.

18   So, the word can carry a great deal more meaning than the simple

19   literal dictionary definition of the term. And different words have different

20   connotative meanings to different demographic groups.

21   And that is exactly what we are talking about here. We are talking

22   about the user using loaded words, words that are used by advertisers all the

23   time. And mapping out particular demographic segments using those words.

24   So, claims 39 and 42 -- the rejections of claims 39 and 42 fail

25   because neither Skillen nor Loeb contain anything related to connotation,

26   and neither Skillen nor Loeb contain anything related to demographics and,

1 furthermore, neither Skillen nor Loeb contain the relationship between the

2 two. Paragraph 18 of my client's of my application -- if I said that, I am sorry

3 -- does contain that, and it goes into some detail as to how that works.

4   So, for the reasons we have presented, we believe that the Examiner's

5 rejections in this case, based on 102 and 103, should be reversed and we

6 believe that my client's claims -- actually we solicit that action by this Court.

7   Thank you.

8   JUDGE THOMAS: Is there any other final comments or questions

9 by the panel?

10   JUDGE MacDONALD: No.

11   JUDGE THOMAS: All right, sir. Thank you very much.

12   MR. SZMANDA: Thank you, sir.

13

14

15

16   (Whereupon, the proceedings concluded.)